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| EXAMINER |
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THEXTON, MATTHEW

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| ART UNIT | PAPER NUMBER |
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1714

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,472

Applicant(s)

STOIANOVICI ET AL.

Examiner

Matthew A. Thexton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____.

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DETAILED ACTION

Election/Restrictions

Applicant has elected without argument and with traverse in paper received 17 July 2003. The review of the art by the Examiner has resulted in the withdrawal of the election requirement for component A, because it is clear that volatile corrosion inhibitors are notoriously well known and applicant's disclosure merely recites well known volatile corrosion inhibitors in the claimed formulations. Since no arguments were made to explain the traverse, the restriction is otherwise deemed proper.

Claims 1-10 are generic with respect to elected B component, linear and slightly branched hydrocarbons forming mineral waxes (paraffin, microcrystalline paraffin, polyethylene, polyolefins), therefore no claims are withdrawn since none are limited to non-elected species.

Information Disclosure Statement

The information disclosure statement received 29 April 2002 has been considered.

Claim Rejections - 35 USC § 112 and 35 USC § 101

Claim 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claim 11 provides for the use of stoppers, but since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

This claim is so indefinite that it cannot be treated on the merits.

Specification

Claims 4-10 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4-10 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

Claims 3-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

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The phrase "chosen from the group comprising" and similar phrases are unacceptable because comprising is open-ended and thus the group is open-ended and undefined. This should be rephrased in accordance with US practice along the lines of "selected from the group consisting of".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bortolussi et al. (BR 9001035, as understood from the USPTO translation) in view of Shibantai et al. (US 4677177).

The Bortolussi reference discloses a "primary" formulation of volatile corrosion inhibitor and polyolefin (page 9, lines 3-8, translation) which may be processed at temperatures as low as 80 C (page 12, lines 3-8, translation). This is then formulated with polymer which is then extruded into self supporting film. The reference does not disclose forming stoppers.

The Shibantai reference discloses a preblend of volatile corrosion inhibitor plus cyclodextrin to form a clathrate. This is formulated with thermoplastic resin and shaped by extrusion, injection molding or expansion molding. Example 5 demonstrates that an article may be molded therefrom.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the composition of Bortolussi in injection molded articles, such as a stopper, in view of the suggestion of the Shibanaï reference, since both references are directed to the same endeavor.

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

There is no suggestion in the prior art to employ the sub-genus of the elected invention consisting of linear and slightly branched hydrocarbons forming mineral waxes (paraffin, microcrystalline paraffin, petrolatum) in a preblend with volatile corrosion inhibitors and further formulated with a polymer formed into a stopper. The closest prior art appears to be Bortolussi et al. (BR 9001035, as understood from the USPTO translation) which discloses formulating a premix (termed "primary" mix in the reference) employing polymers such as olefins and copolymers (page 9, lines 3-8, translation) which are processed at temperatures as low as 80 C and which are not suggestive of lower melting waxy materials.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 09/622448. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 'stopper' of 10/031472 appears to be merely another form of 'packaging article' of the other application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cited prior art discloses mixtures of volatile corrosion inhibitor with polymers: Fessler et al. (US 2829080), Boerwinkle et al. (US 4290912), Lozano et al. (US 6033599), and Hashiudo et al. (US 4124549).

Cited prior art discloses mixtures of volatile corrosion inhibitor with wax (e.g., Wachter et al (US 2643176) and Ruzevick et al. (US 3425954)).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew A. Thexton whose telephone number is 703-305-5085. The examiner can normally be reached on Monday-Friday, 8:30 to 6.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasudevan S Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Matthew A. Thexton
Primary Examiner
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August 13, 2003